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EXAMINER

BORISSOV, IGOR N

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GLENN PETKOVSEK

Appeal 2008-1761
Application 09/784,479
Technology Center 3600

Decided: July 29, 2008

Before LINDA E. HORNER, ANTON W. FETTING, and
MICHAEL W. O'NEILL, *Administrative Patent Judges*.

O'NEILL, *Administrative Patent Judge*.

DECISION ON APPEAL

Glenn Petkovsek (Appellant) seeks our review under 35 U.S.C. § 134 of the final rejection of claims 1-18. We have jurisdiction under 35 U.S.C. § 6(b) (2002). We reverse.

The Appellant's claimed invention relates to a system and a method from which customers may interact on a computer network with a database

to generate a communication that complies with the requirements for delivery of mail by a special service. Claim 1, reproduced below, is representative of the subject matter on appeal [bracketed matter and some paragraphing added].

1. A system to assist a user with preparation and mailing of a communication requiring delivery by a special service wherein the special service has fees associated with postage and services to effect the delivery by the special service, the system comprising:

[a] a computer accessible site that automatically provides the preparation of the communication requiring the delivery by the special service and automatic payment of the fees associated with the postage and the services required to effect the delivery by the special service;

[b] a computer for accessing the computer accessible site via a computer network; and

[c] a database accessible by the computer via the computer network wherein the database is remotely located with respect to the computer wherein the database

[c1] stores the communication,

[c2] stores instructions to assist the user to complete the communication,

[c3] stores criteria regarding selection of the special service appropriate for the delivery of the communication[,] and

[c4] stores requirements to effect the delivery of the communication by the special service

[d] wherein the communication in the database is selected via the computer and further wherein the communication is automatically prepared in compliance with the requirements of the delivery by the special service[,] and

[e] further wherein the communication is automatically mailed by the special service via the computer accessible site.

The Appellant seeks our review of the Examiner's rejection of claims 1-18 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent Appl. No. 2002/0120680 A1, published August 29, 2002 to Greco and U.S. Patent Appl. No. 2002/0019741 A1, published February 14, 2002 to Heston.

The Examiner finds Greco teaches a database that stores a communication, instructions to assist the user to complete the communication, criteria regarding selection of the special service appropriate for the delivery of the communication, and requirements to affect the delivery of the communication by the special service, as recited in independent claims 1 and 12. (Answer 3-4 and 7-8.) The Appellant contends that Greco describes an electronic document service that utilizes a database storing data fields that contain user identification data, a link information field, a service provider information field, and a permissions field. (App. Br. 10.) The Appellant contends what is stored in some of the data fields are links to web sites maintained by the service providers, information regarding the type of services provided by the service providers, and permissive uses of the services by each user. (*Id.*)

Greco describes two databases 700 and 750, containing multiple datafields. The datafields in database 700 are a user identification field 710 and a user data field 720 divided into subfields of: link information field 722, service provider information field 724, and a permission field 726. (Greco ¶ 0082.) The datafields in database 750 are link information field 760 and provider information field 770. (Greco ¶ 0084.) The link

information fields 722 and 760 contain uniform resource locators (URLs) to web sites maintained by the service providers for the user to access. The provider information fields 724 and 770 contain information such as the type of services provided by the provider. The permissions field 726 contains permissible uses of the service for an individual user. (Greco ¶ 0083-0084.) As such, Greco's database does not store a communication, instructions to assist the user to complete the communication, criteria regarding selection of the special service appropriate for the delivery of the communication, and requirements to affect the delivery of the communication by the special service.

In rejecting claims under 35 U.S.C. § 103(a), the examiner bears the initial burden of establishing a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992); *see also In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the appellant. *See Oetiker*, 977 F.2d at 1445; *see also Piasecki*, 745 F.2d at 1472. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. *Id.*

The Examiner relied on Greco to teach the database. (Answer 3-4 and 7-8.) In addition, the Examiner relied on Greco to teach the storing of the communication, instructions, criteria, and requirements. The Appellant contends that Greco fails to teach the storing of the communication, instructions, criteria, and requirements. (App. Br. 10-11.) Based on the evidence as a whole and the persuasiveness of the arguments, we determine the Appellant has shown an error in the Examiner's rejection with respect to Greco's database not storing a communication, instructions to assist the user

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to complete the communication, criteria regarding selection of the special service appropriate for the delivery of the communication, and requirements to affect the delivery of the communication by the special service. The Examiner does not use Heston to cure the deficiencies in Greco.

Accordingly, we do not sustain the Examiner's rejection of claims 1 and 12 or their dependent claims 3-11 and 13-18 as unpatentable over Greco and Heston. The decision of the Examiner to reject claims 1-18 is reversed.

REVERSED

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